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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,461	06/22/2006	Yuichi Ito	1000023-000111	3314

21839 7590 07/24/2008  
BUCHANAN, INGERSOLL & ROONEY PC  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER
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MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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07/24/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/584,461	<b>Applicant(s)</b> ITO ET AL.	
	<b>Examiner</b> Sanza L. McClendon	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/07 and 6/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**  
***Response to Amendment***

1. In response to the Amendment received on 4/14/2008, the examiner has carefully considered the amendments.
2. The Declaration under 37 CFR 1.132 filed 4/14/2008 is sufficient to overcome the rejection of claims 1-4, 7 and 9 based upon the 35 USC 102(b) as being anticipated by Yasuo et al (JP 2002-188025) and the rejection of claims 1-9 under 35 USC 102(b) as being anticipated by Makoto et al (08-085775).
3. The Yasuo et al reference requires the presence of an epoxy compound as an essential component, which is outside the scope of the instantly written claims. Regarding the Makoto et al, while said reference teaches a composition comprising an oxetane compound and a vinyl ether compound (3rd embodiment—see [0057]) and the vinyl ether compound is added in amounts from five to 95 weight sections to total quantity 100 weight section of the compound having the oxetane compounds, i.e. the combined amount of vinyl ether and oxetane compound must total to 100 weight sections of the composition, and this ratio encompasses applicant's claimed amount from at least 5 up to 10 % by weight for the vinyl ether component (c) as found in claim 1, in the examiners opinion after reconsideration of the reference believes that one of ordinary skill in the art, at the time of the invention, would have expected to find a cure that resulted in a tack-free coating (good curability). The reasons being while Makoto et al does teach per section [0057] that the cure rate of the composition comprising a vinyl-ether is further improved, it appears that Makoto et al is teaching that the addition an oxetane compound having at least 4 oxetane groups improves the curability. However, the examiner deems that one of ordinary skill in that art using the cited reference would not have expected to find that the addition of 0.01 to 10 parts by weight of a compound that generates a carbocation by the action of an active species generated by the cationic polymerization initiator by electromagnetic waves or particle beam to have good light transmissivity. The cited reference teaches that if too much onium salt (cationic initiator is added), i.e., above 20% by weight, that the light transmittance becomes poor. However, the reference is silent with regard to light transmittance with regard to the combination of an oxetane compound having at least 4 oxetane groups and a vinyl ether. Thus in this instance the property is unexpected.
4. Please note while the Declaration is sufficient to overcome the applied references, it is not commensurate in scope with claims, it appears to be narrower in scope since component (C) can be any compound that generates a carbocation by reaction with the active species generated when the cationic initiator is exposed to electromagnetic radiation. Thus, new rejections will be applied from the prior art the read on applicant's instantly written claims—see below.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Niwa et al (JP 08-269392).

8. Niwa et al sets forth a composition comprising an oxetane compound and a cationic photoinitiator that can additionally comprise from 5 to 95 parts by weight of a vinyl ether compound. Niwa et al teaches the cure rates is improved by the addition of vinyl ether to the oxetane composition—see [0065]. The cationic photoinitiator can be an onium salt of the type described in sections [0053] to [0059]. Said composition is useful in coating optical fibers, which can be colored (i.e., ink or paint) and is adhesive. It is deemed that the applicant's 0.01 to 10% by weight of component (C) is encompassed in the range taught by Niwa et al and thus anticipated. It is also deemed that one of ordinary skill in that art would have expected good light transmittance in the cured product comprising the mixture of an oxetane and vinyl ether because it is known in the optical fiber art that yellowing of the cured coating caused problems in attenuation. Thus, the invention is anticipated by the reference.

9. Claims 1-6, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Niwa et al (JP 08-231938).

10. Niwa et al sets forth a composition comprising an oxetane compound and a cationic photoinitiator that can additionally comprise from 5 to 95 parts by weight of a vinyl ether compound. Niwa et al teaches the cure rates is improved by the addition of vinyl ether to the oxetane composition—see [0065]. The cationic photoinitiator can be an onium salt of the type described in sections [0053] to [0059]. Said composition is useful as a laminate adhesive. It is deemed that the applicant's 0.01 to 10% by weight of component (C) is encompassed in the range taught by Niwa et al and thus anticipated. Per examples, it

is taught that the compositions have good appearance—see [0077] and Table 2, 3<sup>rd</sup> column for example 3. Thus, the invention is anticipated by the reference.

11. Claims 1-4, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Niwa et al (JP08-218296).

12. Niwa et al sets forth a composition comprising an oxetane compound and a cationic photoinitiator that can additionally comprise from 5 to 95 parts by weight of a vinyl ether compound. Niwa et al teaches the cure rates is improved by the addition of vinyl ether to the oxetane composition—see [0065]. The cationic photoinitiator can be an onium salt of the type described in sections [0053] to [0059]. Said composition is useful for coating paper and other substrates. Said coating composition is taught to have high gloss. It is deemed that the applicant's 0.01 to 10% by weight of component (C) is encompassed in the range taught by Niwa et al and thus anticipated. Per examples, it is taught that the compositions have good gloss—see [0079] and Table 2, 3<sup>rd</sup> column for example 3. Thus, the invention is anticipated by the reference.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanza L McClendon/

Primary Examiner, Art Unit 1796

SMc